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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,134	11/01/2000	Todd Siegel	00688081	4080

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EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/704,134	SIEGEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John R. Paradiso	3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 lines 6-7 recites "package templates are mounted on a common X-Y mechanical drive" and claim 6 lines 6-7 recites "package templates are mounted on individual X-Y mechanical drive". In both instances, it appears that the the package templates are mounted on conveyors moved by X-Y mechanical drives, rather than the drives themselves.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over KNUDSEN (US 4490963) in view of BOUTHINETTE (US 6023916) and HAYES ET AL (US 6334980).

KNUDSEN discloses an automated pharmaceutical packaging machine in which pharmaceutical products are dispensed from an array of sources (16) into each cavity of a plurality of product package cavities (14) and transferring them into a product package member and then to a package sealer downstream. (See KNUDSEN columns 3 and 4 and figures 1 and 12.)

5. KNUDSEN does not specifically disclose the pharmaceutical products being dispensed into product package templates.

6. BOUTHINETTE discloses a packaging kit with product package template cavities corresponding to cavities of a product package member. (See BOUTHINETTE columns 5 and 6 and figures 2, 7, and 11.)

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of KNUDSEN by dispensing the pharmaceutical products into product package templates, as taught by BOUTHINETTE, in order to ensure facilitate product placement into popular compartmented containers.

8. The combination of KNUDSEN and BOUTHINETTE does not disclose the use of an X-Y mechanical drive to move the package templates.

9. HAYES ET AL discloses an apparatus in which a dispensing apparatus (602a-c) which dispenses specific quantities of fluid to specific places on a template (722) which is moved by an X-Y positioning table (606). An X-Y (608) moves the positioning table so that the correct spots in the template are positioned under the correct dispensers. (See HAYES ET AL column 11 line 38 to column 12 line 19 and figure 9.)

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10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the X-Y positioning table, as taught by HAYES ET AL, in the combination of KNUDSEN and BOUTHINETTE in order to more accurately place the products.

11. Regarding claims 2 and 7, Applicant is given Official Notice that the use of pneumatic cylinders for movement of machine assemblies is notoriously well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use pneumatic cylinders to move the parts of the combination of KNUDSEN, BOUTHINETTE, and HAYES ET AL in order to move the assemblies in an easily controllable manner.

12. Regarding claims 3 and 8, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the combination of KNUDSEN, BOUTHINETTE, and HAYES ET AL with any number of arrays and funnels, as determined to be most efficient, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

13. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over TAKEMASA ET AL (US 5765606) in view of BOUTHINETTE (US 6023916).

14. TAKEMASA ET AL discloses an automated pharmaceutical packaging machine in which pharmaceutical products are dispensed from an array of sources (7) into each cavity of a plurality of product package cavities (33) and transferring them into a product package member. (See TAKEMASA ET AL columns 4 and 5 and figure 6.)

15. TAKEMASA ET AL does not specifically disclose the pharmaceutical products being dispensed into product package templates.

16. BOUTHINETTE discloses a packaging kit with product package template cavities corresponding to cavities of a product package member. (See BOUTHINETTE columns 5 and 6 and figures 2, 7, and 11.)

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of TAKEMASA ET AL by dispensing the pharmaceutical products into product package templates, as taught by BOUTHINETTE, in order to ensure facilitate product placement into popular compartmented containers.

18. The combination of TAKEMASA ET AL and BOUTHINETTE does not disclose the use of an X-Y mechanical drive to move the package templates.

19. HAYES ET AL discloses an apparatus in which a dispensing apparatus (602a-c) which dispenses specific quantities of fluid to specific places on a template (722) which is moved by an X-Y positioning table (606). An X-Y (608) moves the positioning table so that the correct spots in the template are positioned under the correct dispensers. (See HAYES ET AL column 11 line 38 to column 12 line 19 and figure 9.)

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20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the X-Y positioning table, as taught by HAYES ET AL, in the combination of TAKEMASA ET AL and BOUTHINETTE in order to more accurately place the products.

21. Regarding claims 2 and 7, Applicant is given Official Notice that the use of pneumatic cylinders for movement of machine assemblies is notoriously well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use pneumatic cylinders to move the parts of the combination of KNUDSEN, BOUTHINETTE, and HAYES ET AL in order to move the assemblies in an easily controllable manner.

22. Regarding claims 3 and 8, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the combination of KNUDSEN, BOUTHINETTE, and HAYES ET AL with any number of arrays and funnels, as determined to be most efficient, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Response to Arguments***

23. Applicant's arguments filed 3/19/2003 have been fully considered but they are not persuasive.

24. Applicant states on page 2 of his Response that "Applicants note that there is no teaching or suggestion regarding the mounting of the product package templates on an X-Y mechanical drive".

Examiner agrees with this argument and this deficiency is remedied in the above rejections.

25. Applicant states on page 2 of his Response that "Applicants not that the Bouthiette reference is merely directed to a manual kit that is used to sort pills..."

However, the fact that it is a manual process is irrelevant, since the reference is not explained as anticipating the claims, but rather as a teaching reference to show a product package template cavities corresponding to cavities of a product package member



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***Reference Citations***

26. The following prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:


- BIVIRT ET AL discloses an apparatus for dispensing fluids using an X-Y drive to position the containers.
- HAYES ET AL (US 5658802) discloses an apparatus for dispensing fluids using an X-Y drive to position the containers.

***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center receptionist.

  
Examiner John Paradiso: (703) 308-2825

July 27, 2003

**Additional Phone Numbers:**

Supervisor Rinaldi Rada: (703) 308-2187  
Receptionist: (703) 308-1148  
Customer Service: (703) 306-5648

Fax (Direct to Examiner): (703) 746-3253  
Fax (TC 3700 Official): (703) 872-9302  
Fax (TC 3700 After Final): (703) 872-9303